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09/654,025	09/01/2000	Mark L. Yoseloff	PA0463.ap.US	5837

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EXAMINER

WHITE, CARMEN D

ART UNIT

PAPER NUMBER

3714

FL

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/654,025

Applicant(s)

YOSELOFF ET AL.

Examiner

Carmen D. White

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 and 15-22 is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### ***Claim Objections***

Claim 9 objected to because of the following informalities: the claim recites "the bonus event" in line 4 of the claim. This limitation lacks antecedent basis. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by ***O'Halloran*** (6,439,993).

Regarding claims 1-9, O'Halloran teaches a method and apparatus of playing a video wagering game that comprises a player placing a wager on a reel-slot-type video game event having a plurality of symbol positions; displaying a plurality of randomly selected game symbols on a display, each symbol appearing in a designated symbol position; upon the occurrence of a predetermined triggering event, randomly selecting between zero and fewer than a maximum number of viewable symbol positions as a wild symbol position (col. 3, lines 37-44 teaches that the number of expanding wild card symbols can be in the range of 1 to n-1 where n is the number of reels- this has been

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interpreted as meeting the instant limitation of between zero and fewer than a maximum number of viewable symbol positions); converting each symbol displayed within each selected wild symbol position to a wild symbol; and determining game outcomes based on the displayed game symbols and wild symbols in a single game event (col. 2, lines 54-67 and col. 3, lines 13-16).

Regarding claims 12-14, O'Halloran teaches all the limitations of the claim as discussed above. Further, col. 3, lines 37-44, see above, meets the instant claim limitation of randomly selecting at least one, and fewer than all symbol positions as wild symbol positions.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over

***O'Halloran.***

Regarding claim 10, O'Halloran teaches all the limitations of the claim as discussed above. O'Halloran is silent regarding the explicit teaching of the triggering symbol comprising a symbol on both a first and fifth reels. However, O'Halloran teaches that the symbol can appear in various reel positions. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this

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feature in O'Halloran in order to make it easier to predict various winning outcomes by the gaming authority.

***Allowable Subject Matter***

Claim 11 is allowed. *(See previous office action- paper #14, 9/10/03, which is incorporated herein by reference for reasons for indication of allowable subject matter)*

Claims 15-22 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: O'Halloran as well as the other prior art references of record lack teaching the triggering of a bonus event and the determination of a bonus outcome.

***Examiner's Response to Applicant's Remarks***

Applicant argues that O'Halloran does not teach play of a base game, a display of a special event, and the special event triggering a subsequent event wherein viewable symbol positions are randomly selected as wild symbol positions. The examiner disagrees. Applicant is arguing language that is different from the claim language. The examiner recognizes, see above reference to "Allowable subject matter", that O'Halloran lacks the explicit disclosure of a bonus event and a bonus outcome, which is disclosed in instant claims 15-22. However, O'Halloran clearly teaches the broader limitations of instant claims 1-10 and 12-14 that refer to a predetermined triggering event {appearance of a wild card symbol} and a second game event {prize awards for combinations of wild card symbols and one or more other symbols} based on the predetermined combinations of the displayed game symbols and

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wild symbols (see col. 1, lines 38-44). Therefore instant claims 1-10 and 12-14 remain rejected.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


***USPTO Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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